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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,499	08/01/2001	Kenzo Sekiguchi	2922.0045	3225
5514	7590	04/20/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				HUNTSINGER, PETER K
ART UNIT		PAPER NUMBER		
		2625		

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/918,499	SEKIGUCHI, KENZO
	Examiner Peter K. Huntsinger	Art Unit 2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 January 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 1-11 is/are allowed.
- 6) Claim(s) 12- 23 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 23 is rejected because the claimed invention is directed to non-statutory subject matter. The computer program claimed is merely a set of instructions per se. Since the computer program is merely a set of instructions not embodied on a computer readable medium to realize the computer program functionality, the claimed subject matter is not statutory. See MPEP § 2106 IV.B.1.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 12, 13, 15, 17, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyoda U.S. Patent 6,094,277, and in further view of Killcommons et al. U.S. Patent 6,424,996 and applicant's admitted prior art.

Referring to claim 12, Toyoda discloses a communication method comprising: and inputting step, of inputting image data representing an image (col. 3, lines 55-56); transmitting step of transmitting an electronic mail to which the image data inputted by

said input means is attached (col. 3, lines 33-36); a receiving step of receiving an electronic mail for notifying an error (col. 4, lines 42-47); an analyzing step of analyzing the electronic mail for notifying the error received in said receiving step (col. 4, lines 45-48). Toyoda does not disclose expressly converting the image into a smaller capacity. Killcommons et al. disclose a converting step of converting a capacity of the image data inputted by said input means into a smaller capacity (col. 9, lines 50-67), and a controlling step of automatically carrying out a controlling operation so as to retransmit the electronic mail to which the image data with the size thereof converted in said converting step (col. 9, lines 50-67). A user is able to manually compress the email and manually resend the email. Toyoda and Killcommons et al. are combinable because they are from the same field of electronic messaging of image data. At the time of the invention, it would have been obvious to one of ordinary skill in the art to compress image data in an email in the system of Toyoda. The motivation for doing so would have been to reduce the size of the email being sent. Further, it is common to compress image files because they require greater memory space than text files. Toyoda and Killcommons et al. do not disclose expressly an error that the transmitted email is too large. The applicant's admitted prior art discloses an error indicating that an email is too large (page 1, paragraph 8). At the time of the invention, it would have been obvious to retransmit an email after receiving an error indicating the email is too large. The motivation for doing so would have been to send an email of an acceptable size to a recipient. Therefore, it would have been obvious to combine Killcommons et

al. and the applicant's admitted prior art with Toyoda to obtain the invention as in claim 12.

Referring to claim 13, Killcommons et al. disclose wherein said converting step comprises converting the capacity of image data specified by the electronic mail analyzed in said analyzing step (col. 9, lines 50-67).

Referring to claim 15, Killcommons et al. disclose wherein said converting step comprises reducing the capacity by reducing a size of an image represented by the image data inputted in said input step (col. 9, lines 50-67).

Referring to claim 17, Killcommons et al. disclose wherein said converting means comprises reducing the capacity by raising a compression rate of the image data inputted in said input step (col. 9, lines 50-67).

Referring to claim 22, Killcommons et al. disclose wherein: said controlling step comprises repeating the conversion in said converting step and the retransmission in said transmitting step every time an electronic mail for notifying an error is received in said receiving step (col. 9, lines 50-67). A user is able to manually compress the email and manually resend the email.

4. Claims 14 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyoda U.S. Patent 6,094,277, Killcommons et al. U.S. Patent 6,424,996, and the applicant's admitted prior art as applied to claim 12 above, and further in view of Kodaira et al. U.S. Patent 6,868,183.

Referring to claim 14, Killcommons et al. disclose converting an image into smaller data but do not disclose expressly lowering a resolution of an image. Kodaira et al. disclose wherein said converting means reduces the capacity by lowering a resolution of an image represented by the image data inputted by said input means (col. 24, lines 31-44). Toyoda and Kodaira are combinable because they are from the same field of image data processing. At the time of the invention, it would have been obvious to one of ordinary skill in the art to lower the resolution of an image in the system of Toyoda. The motivation for doing so would have been to reduce the size of the image file. Further, the commonly used image compression format JPEG compresses image data by lowering the resolution of an image. Therefore, it would have been obvious to combine Kodaira et al. with Toyoda, Killcommons et al., and the applicant's admitted prior to obtain the invention as in claim 14.

Referring to claim 19, Kodaira et al. disclose wherein said converting means reduces the capacity by converting the image data which is multivalued image data, inputted by said input means, into binary image data (col. 24, lines 31-44).

Referring to claim 20, Kodaira et al. disclose setting means for setting for said converting means one of a plurality of conversion methods to be used; and wherein said converting means converts the capacity by the conversion method set by said setting means (col. 24, lines 31-44).

Referring to claim 21, Kodaira et al. disclose a communication apparatus according to claim 1, wherein said converting means converts the capacity by using a combination of a plurality of converting methods (col. 24, lines 31-44).

5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Toyoda U.S. Patent 6,094,277, Killcommons et al. U.S. Patent 6,424,996, and the applicant's admitted prior art as applied to claim 12 above, and further in view of Kaneya J.P. Patent 411196218A.

Referring to claim 16, Killcommons et al. disclose reducing the data size of an image by compressing the data but do not disclose dividing the data into pieces. Kaneya discloses wherein said converting means reduces the capacity per electronic mail by dividing the image data inputted by said input means into a plurality of pieces. (English translated abstract). Toyoda and Kaneya are combinable because they are from the same field of transmitting image data over electronic messaging. At the time of the invention, it would have been obvious to one of ordinary skill in the art to divide an image into pieces in the system of Toyoda. The motivation for doing so would have been to reduce the size of a file and allow the file to be transmitted using email. Further, the dividing a file into separate pieces is common for reducing the time needed to transmit a file over the internet. Therefore, it would have been obvious to combine Kaneya with Toyoda, Killcommons et al., and the applicant's admitted prior to obtain the invention as in claim 16.

6. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Toyoda U.S. Patent 6,094,277, Killcommons et al. U.S. Patent 6,424,996, and the applicant's

admitted prior as applied to claim 12 above, and further in view of Fukasawa U.S. Patent 6,243,174.

Referring to claim 18, Killcommons et al. disclose reducing the data size of an image by compressing the data but do not disclose converting color image data into black and white image data. Fukasawa discloses wherein said converting means reduces the capacity by converting the image data which is color image data, inputted by said input means, into black-and-white image data (col. 5, lines 47-55). Toyoda and Fukasawa are combinable because they are from the same field of facsimile devices. At the time of the invention, it would have been obvious to one of ordinary skill in the art to convert color data into black and white data for the system of Toyoda. The motivation for doing so would have been to reduce the size of an image. Further, grey scale is a common feature of facsimile devices that is used to reduce the cost of printing by not utilizing color ink. Therefore, it would have been obvious to combine Fukasawa with Toyoda, Killcommons et al., and the applicant's admitted prior to obtain the invention as in claim 18.

Allowable Subject Matter

7. Claims 1-11 allowed.

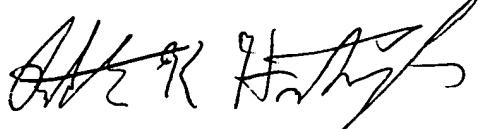
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571)272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PKH



KING Y. POON
PRIMARY EXAMINER